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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,460	10/10/2001	Andrew Ernest Fano	10022/187	4729

28164 7590 11/25/2002

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EXAMINER

DIXON, THOMAS A

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 11/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/975,460

Applicant(s)

FANO, ANDREW ERNEST

Examiner

Thomas A. Dixon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 20-41 is/are pending in the application.
- 4a) Of the above claim(s) 1-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-24,26-32,34-38,40-41 is/are rejected.
- 7) ☒ Claim(s) 25,33,39 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. The new title is acceptable.

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 20, 27, 28, 35, 36, 41 are rejected under the judicially created doctrine of double patenting over claims 1, 9 of U. S. Patent No. 6,317,718 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

The claims of the instant application are a separation of the features claimed in the previous application, now patent 6,317,718.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during

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prosecution of the application which matured into a patent. See also MPEP § 804.

3. Claim 40 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 39. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 20-23, 26, 29-31, 34, 36 rejected under 35 U.S.C. 102(e) as being anticipated by Bouve et al (5,682,525).

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As per Claim 20, 28, and 36.

Bouve et al ('525) discloses:

obtaining information identifying an item of merchandise from a user, see page column 2, lines 26-31;

determining a physical location of a user, see column 2, lines 46-52;

querying a computerized network of information utilizing a query based on the information identifying the item of merchandise and the physical location of the user, see column 2, lines 26-28, column 3, line 45, column 11, lines 15-19 and lines 24-29;

receiving from a retailer-based agent in response to the query the customized offer for sale of the item of merchandise from the retailer proximate to the user, see column 11, lines 8-14.

displaying the customized offer and a physical location of the retailer, see column 11, lines 8-14.

As per Claim 21, 29

Bouve et al ('525) further discloses a list, see column 2, lines 13-16.

As per Claim 22, 30.

Bouve et al ('525) further discloses a query based on the list and user's location, see column 2, lines 13-16 and column 11, lines 3-14.

As per claim 23, 31.

Bouve et al ('525) further discloses the list is generated by the user at a location remote from the retailer, see column 6, lines 39-67.

As per Claim 26

Bouve et al ('525) further discloses the internet, see column 11, lines 24-30.

As per Claim 34

Bouve et al ('525) further discloses pattern recognition to enhance the location of pertinent information, see column 8, lines 63-67.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 24, 32, 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bouve et al (5,682,525).

As per Claim 24, 32, 38.

Bouve et al ('525) further discloses displaying, see column 11, lines 8-14.

Bouve et al ('525) does not specifically disclose displaying a list of items or merchandise available at the retailer and the prices associated therewith.

This limitation is seen to be non-functional descriptive material which will not distinguish the invention from the prior art in terms of patentability, see *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 101 (Fed. Cir. 1983).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to display a list of items and the prices to make potential consumers aware of the potential purchases and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As per Claim 37.

Bouve et al ('525) does not specifically disclose parsing the terms based on predefined criteria to create the query.

Official notice is taken that parsing is old and well known in the database arts.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to parse the input to create a query because this would save time for the recipient of the information.

### ***Allowable Subject Matter***

6. Claims 25, 33, 39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

As per claims 25, 33, 39.

The prior art of record, specifically Bouve et al (5,682,525), does not disclose or fairly teach determining the closest retailers surrounding the user and suggesting items of merchandise for sale at the closest retailers surrounding the user.

### ***Prior Art Made of Record***

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7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

EP 0 865 006 A2 to Kip is the closest foreign art which discloses shopping and GPS.

Remembrance Agent by Rhodes et al is the closest non-patent literature which discloses a wearable computer with GPS which could know it's lunch time and make recommendations of restaurants within a few blocks of the wearer.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (703) 305-4645. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



Thomas A. Dixon  
Examiner  
Art Unit 3629

November 22, 2002